

## **REMARKS**

Claims 1-45 are currently pending. In the November 17, 2004, Office Action, the Examiner rejected claims 1-6, 14, 16-22, 29, 31-37 and 43 under 35 U.S.C. § 103(a) as being unpatentable over the FinePrint documentation (hereinafter “FinePrint”) in view of the FinePrint Web review (hereinafter “FinePrint Web”). The Examiner also rejected claims 7-12, 15, 22-27, 30, 36-41 and 44 under 35 U.S.C. § 103(a) as being unpatentable over FinePrint and FinePrint Web, and further in view of U.S. Patent No. 6,122,657 to Hoffman Jr. et al., (hereinafter “Hoffman”). Finally, the Examiner rejected claims 13, 28, and 42 under 35 U.S.C. § 103(a) as being unpatentable over FinePrint and FinePrint Web, and further in view of Bickmore et al., “Digester: Device-Independent Access to World Wide Web” (hereinafter “Bickmore”). Applicant has amended selected claims for clarification purposes, including claim amendments that are unrelated to the pending Office Action. Applicant respectfully traverses the rejections for the reasons set forth hereinbelow.

### **A. FinePrint Web Does Not Qualify As A Prior Art Printed Publication**

Each of the pending rejections relies in part on the Examiner’s implicit assertion that the FinePrint Web review qualifies as prior art to the present application. In particular, the Examiner asserts that the FinePrint Web review was “submitted” on Aug. 18, 2000, and apparently concludes that the submission date qualifies as a publication date for the reference. Applicant respectfully submits that the Aug. 8, 2000 “review submitted” date shown on the [www.5star-shareware.com](http://www.5star-shareware.com) web site does not qualify as a “printed publication” as of that date, and that Examiner has failed to determine the issue or publication date of the FinePrint Web reference. *See*, MPEP § 706.02(a) (“The examiner must determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made.”).

For a reference to qualify as a “printed publication,” there must be “a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.” *See*, MPEP § 2128, quoting *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981). “Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form

it may be, as a 'printed publication' \* \* \* should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.'" (citations omitted).)" *Id.* While electronic publications *can* qualify as prior art, the MPEP states that such disclosures "are considered to be publicly available as of the date the item was publicly posted. Absent evidence of the date that the disclosure was publicly posted, if the publication itself does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)." *See*, MPEP § 2128 ("ELECTRONIC PUBLICATIONS AS PRIOR ART ... Date of Availability).

Applicant respectfully submits that the Examiner has not made the required showing that the FinePrint Web review qualifies as a "printed publication" as of the asserted August 18, 2000 "review submitted" date. While the referenced web page downloaded on Nov. 8, 2004 shows an Aug. 18, 2000 submission date for the FinePrint Web review, a review submission date does not qualify as evidence of a public posting on the web site at that date. **Indeed, the Internet Archive database for this site shows that there were no postings in 2000 for the www.5star-shareware.com/Utilities/Printing-Utilities/finprint-web98.html web site!** *See*, Internet Archive search report attached as Exhibit A. Moreover, the Internet Archive database report for this web site indicates that the FinePrint Web review appeared no earlier than August 9, 2001 – well after the filing date of this application. *See*, Exhibit A. Because the Examiner has not shown that FinePrint Web review qualifies as prior art to the present application, Applicant requests that the obviousness rejections be withdrawn and that all pending claims be allowed.

**B. Claims 1-6, 14, 16-22, 29, 31-37 and 43 Are Not Obvious over FinePrint In View Of FinePrint Web**

Each of pending claims 1-45 requires, with varying degrees of specificity, a document processing sequence whereby one or more user-configurable print parameters are configured as part of a print option before a print request is received and processed in accordance with the print parameters. By configuring the print parameters prior to printing, the present invention may be incorporated in and used by applications, such as web browser applications (*see, e.g.*, claim 1), thereby allowing the printing resource conservation advantage to be selectively applied as desired to individual applications. In contrast, printer driver solutions -- such as exemplified by the FinePrint and FinePrint Web references -- uniformly apply any user-selected print

modifications to any print request received for a particular printer, without regard to whether the application originating the print request requires print modifications.

In this respect, the FinePrint and FinePrint Web references cited by the Examiner typify the prior art discussed by Applicant in the “Background of the Invention” section:

However, a logical division exists between the duties of a printer driver and an application for which the printer driver prints a document. Printer drivers are concerned with accepting a document, preparing a print job for the document within the presentation space of the printing device, possibly rendering the document within that presentation space, and then transmitting the appropriate information to the printing device. In contrast, applications are concerned with presenting and possibly modifying an electronic version of a document and then requesting the printing of a hardcopy version of the document. It is widely assumed by users and application developers that any changes to the content of a document shall be performed only within the processes of an appropriate application and not within the processes of a printer driver.

Hence, it would not be appropriate to create and deploy a print driver with built-in, content-reduction, functionality. Moreover, a user would probably not desire to automatically reduce the content of printed documents across multiple applications, as would occur with use of a printer driver, because some applications are specifically designed for generating documents in a WYSIWYG manner. As noted above, however, there is a specific need by some users to generate hardcopy versions of Web-based documents in a low cost manner.

See, Application, paragraphs 22-23 (emphasis added).

This characterization of the “printer driver” solutions is confirmed by the Examiner’s analysis of the FinePrint references. For example, the FinePrint Web reference discloses that a print command is received before the “FinePrint driver” dialog box is retrieved to permit selection of print options. See, FinePrint Web, p. 2 (description of steps for using FinePrint Web). As seen from the foregoing, the printer driver solutions, such as described in the FinePrint references, require that a print command be selected before the printing selections are made for the particular document, and there is simply no disclosure, suggestion or even hint in the cited references of configuring the print parameters as part of a print option before a print request is received.

Based on the foregoing, the Examiner has not made the *prima facie* obviousness showing that all the claim limitations are taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Where a rejection is based on the assertion that all claim limitations are found in a number of prior art references, the fact finder must determine “[w]hat the prior art teaches,

whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references.” In re Fulton, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004). Applicant submits that the Examiner’s proposed combination of references is not sufficient to render the claims *prima facie* obvious because the proposed combination would change the principle of operation of the prior art invention being modified. In particular, FinePrint Web reference clearly discloses that print options are selected after the print command is selected. See, FinePrint Web, p. 2 (“3. Select the Print command from the File menu ... 4. Select the ‘FinePrint’ item from the Print dialog box. Click OK ... 5. Wait for the FinePrint preview box to appear. 6. Make your printing selections in the dialog and press OK.”). As a result, even if we were to assume that that FinePrint and FinePrint Web references would be combined by one of ordinary skill in the art, the combination still does not meet the claim requirements of configuring one or more print parameters as part of a print option before receiving a print request. See, MPEP, § 2143.03 (“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”).

For at least the foregoing reasons, Applicant respectfully submits that the obviousness rejection of claims 1-6, 14, 16-22, 29, 31-37 and 43 be withdrawn and that the claims be allowed.

**C. Claims 7-12, 15, 22-27, 30, 36-41 and 44 Are Not Obvious over FinePrint and FinePrint Web and Further In View Of Hoffman**

In response to the Examiner’s rejection of claims 7-12, 15, 22-27, 30, 36-41 and 44 as being obvious over FinePrint and FinePrint Web and Hoffman, Applicant respectfully requests reconsideration and withdrawal of the rejection because, as explained above, the FinePrint Web reference does not qualify as a prior art “printed publication.” In addition, the cited FinePrint and FinePrint Web references typify the “printer driver” solutions over which the present invention provides an improvement by configuring the print parameters in an application prior to printing, in contrast to the FinePrint disclosure of applying any user-selected print modifications only after the print command is selected. Finally, Applicant submits that the Hoffman reference would not be combined with the FinePrint and FinePrint Web references by one of ordinary skill in the art to produce Applicant’s print processing invention, since Hoffman discloses a “method

for dynamic filtering of hypertext tags and content” for purposes of controlling “output to the browser which is to be ultimately rendered on screen for the user,” and is completely unconcerned with the print control objectives of the present invention. *See*, Hoffman Patent, Abstract, col. 3, lines 31-34 (emphasis added).

Indeed, once the nature of the Hoffman disclosure is properly understood in terms of controlling the browser display, it becomes clear that the Examiner’s “motivation to combine” evidence is misplaced. In particular, the Examiner asserts that it would be obvious to combine these three references “because all three inventions ultimately save resources.” Office Action, p. 7. However, Hoffman is concerned with controlling “output to the browser which is to be ultimately rendered on screen for the user,” so there are no printing “resources” saved by Hoffman. For at least the foregoing reasons, Applicant respectfully requests that the obviousness rejection of claims 7-12, 15, 22-27, 30, 36-41 and 44 be withdrawn and that the claims be allowed.

**D. Claims 13, 28, and 42 Are Not Obvious over FinePrint and FinePrint Web and Further In View Of Bickmore**

In response to the Examiner’s rejection of claims 13, 28 and 42 as being obvious over FinePrint and FinePrint Web and Bickmore, Applicant respectfully requests reconsideration and withdrawal of the rejection because, as explained above, the FinePrint Web reference does not qualify as a prior art “printed publication.” In addition, the cited FinePrint and FinePrint Web references typify the “printer driver” solutions over which the present invention provides an improvement by configuring the print parameters prior to printing, in contrast to the FinePrint disclosure of applying any user-selected print modifications only after the print command is selected. Finally, Applicant submits that the Bickmore reference would not be combined with the FinePrint and FinePrint Web references by one of ordinary skill in the art to produce Applicant’s print processing invention, since Bickmore discloses a “software system which automatically re-authors arbitrary documents from the World-Wide Web to display appropriately on small screen devices such as PDAs and cellular phones, providing device-independent access to the Web,” and is wholly unconcerned with the print control objectives of the present invention. *See*, Bickmore, Abstract.

As with Hoffman, once the nature of the Bickman disclosure is properly understood in terms of re-authoring web documents for display on small screen devices, it becomes clear that

the Examiner's "motivation to combine" evidence is misplaced. In particular, the Examiner asserts that it would be obvious to combine these three references "because all employ techniques to reduce the amount of resources needed to display a web page." Office Action, p. 13. However, Bickmore is concerned with controlling dynamically re-authoring requested web pages "to achieve the best looking document for a given display size," so there are no printing "resources" saved by Bickmore. To assert, as the Examiner does, that "Bickmore adds a feature to reduce the amount of text displayed, and perhaps printed to enable one to conserve resources," (Office Action, p. 13 (emphasis added)) is to engage in impermissible hindsight reconstruction. Accordingly, Applicant respectfully requests that the obviousness rejection of claims 13, 28 and 42 be withdrawn and that the claims be allowed.

### **CONCLUSION**

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance and requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

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Respectfully submitted,

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## EXHIBIT A



Enter Web Address:

Searched for http://www.5star-shareware.com/Utilities/Printing-Utilities/fingerprint-web99.html

13 Results

\* denotes when site was updated.

### Search Results for Jan 01, 1996 - Nov 03, 2006

1996	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006
0	0	0	0	0	2	2	4	5	0	0
pages	pages	pages	pages	pages	pages	pages	pages	pages	pages	pages
					Aug 09, 2001 *	Jan 02, 2002 *	Feb 05, 2003 *	Feb 07, 2004 *		
					Oct 19, 2001 *	Oct 05, 2002 *	Apr 14, 2003 *	Apr 12, 2004 *		
							Jun 19, 2003	Jul 01, 2004		
							Dec 09, 2003 *	Jul 27, 2004		
								Nov 23, 2004		

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